

Application No. 10/603,321

REMARKS

The disclosure has been updated with respect to the copending applications as suggested by the Examiner on page 2, paragraph 1, of the Official Action.

The rejection of Claims 1 to 3, 8 to 20, 24 to 27, and 29 to 30 under 35 U.S.C. 103(a) as being unpatentable over Patel et al. '684 in view of Vanbesien et al, Cheng et al. and Patel et al. is respectfully traversed.

The Examiner's comments have been reviewed, each of the columns and line numbers referred to by the Examiner have been considered, and it is Applicant's position that the Examiner has not established a prima facie case of obviousness. For example, the Examiner has not pointed out to Applicant where in the '684 patent there is illustrated the combination of components as recited in Claim 1, and more specifically, where there is illustrated a toner process that includes a coagulant and a silica in combination, and wherein the resulting toner possesses a certain shape factor. While some of the components and some of the process conditions as pointed out by the Examiner on pages 2 and 3 of the Official Action may be known, the combination of utilizing a coagulant and a silica, and which components are part of the process, have not been shown by the Examiner to be obvious from the prior art. With respect to the Examiner's comments that surface additives such as silica can be added during the aggregation as suggested by the Vanbesien et al. reference, the Examiner has not pointed out the combination of components being illustrated in this reference including a first and second resin utilizing a crosslinked resin, a second latex containing a resin free of crosslinking, a coagulant, and a silica.

In view of the above and since the primary reference is not believed to render obvious the rejected claims, it is believed that the combination rejection is also no longer applicable. As the Examiner points out, the secondary references teach various surfactants, coagulants, and the

Application No. 10/603,321

like useful in aggregation processes for the formation of toners, also teach polymetal halides and polysulfosilicates, however, the Examiner has not pointed out where the combination of components as recited in Claim 1 and particularly a combination of a coagulant and a silica is illustrated, or would render obvious the rejected claims of the present application, particularly without the benefit of the teachings of the present application as filed.

Moreover, Applicants would consider the submission of a 131 Declaration which should establish conception and reduction to practice of embodiments of the present application, as encompassed by a number of the claims, prior to the January 29, 2003 effective filing date of the 6,767,684 patent.

Furthermore, the Examiner has referred to 35 U.S.C. 103(c), which indicates that subject matter developed by another person, which qualifies as prior art only one or more of subsections (e), (f) and (g) of section 102, should not preclude patentability under this section with the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. This situation exists with respect to the present application and the references being applied by the Examiner, namely the Patel et al. '684 patent and the Patel et al. '658 patent, both of which are owned by a common Assignee, Xerox Corporation, as a review of these files will readily reveal.

The rejection of Claims 28 and 31 under 35 U.S.C. 103(a) as being unpatentable over Patel et al. 6,767,684 is respectfully traversed. The arguments as presented herein are believed to be equally applicable to Claims 28 and 31. The Examiner in addition refers Applicant to column 21, lines 8 to 26, concerning the use of silica. The silica in column 21 refers to the addition of surface additions, such as silica, to the toner that results contrary to the situation with rejected Claim 1 wherein the silica together with the


Application No. 10/603,321

coagulant is part of the process for forming the toner. Accordingly, it is believed that these claims are also in condition for allowance.

Concerning Claims 4 to 7 and 21 to 23, Applicant appreciates the Examiner's indication that these claims would be allowable if rewritten in independent form, however, this action has not been accomplished at the present time in view of the comments presented herein with respect to the rejected claims. Accordingly, it is respectfully urged that the Examiner reconsider his positions and allow the present application.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby requested to call Eugene O. Palazzo, at Telephone Number 585-423-4687, Rochester, New York.

Respectfully submitted,



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